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3 RECORD OF ORAL HEARING  
4 UNITED STATES PATENT AND TRADEMARK OFFICE  
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7 BEFORE THE BOARD OF PATENT APPEALS  
8 AND INTERFERENCES  
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11 Ex parte KEIICHI KOSHIBA  
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14 Appeal 2010-000338  
15 Application 09/610,107  
16 Technology Center 2400  
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19 Oral Hearing Held: October 12, 2010  
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23 Before JOHN C. MARTIN, THOMAS S. HAHN and  
24 CARL W. WHITEHEAD, JR., Administrative Patent Judges.  
25

26  
27 ON BEHALF OF THE APPELLANT:  
28

29  
30 JOSHUA POSNER, ESQUIRE  
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1           The above-entitled matter came on for hearing on Tuesday,  
2   October 12, 2010, commencing at approximately 9:35 a.m., at the U.S.  
3   Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia,  
4   before Lorie B. Allen, Notary Public.

5           JUDGE MARTIN: Good morning, Mr. Posner.

6           MR. POSNER: Thank you.

7           JUDGE MARTIN: Do you have a business card for the  
8   reporter?

9           MR. POSNER: I do not.

10          JUDGE MARTIN: Okay.

11          MR. POSNER: If it may please the panel, may I approach to  
12   provide a few highlighted materials that are already in the record.

13          JUDGE MARTIN: Yes, please.

14          MR. POSNER: Okay. I provided a -- I made one set of this, or  
15   three sets, I'm sorry. It's just a copy of the claims and then two figures, one  
16   from the cited reference and one from the application.

17          JUDGE MARTIN: All right. Thank you.

18          MR. POSNER: This hopefully will make this sort of an easy  
19   conversation. If it may please the panel, I'm prepared to proceed.

20          JUDGE MARTIN: Yes, please.

21          MR. POSNER: Okay. We requested this hearing for two  
22   primary purposes, and the first is to make sure that we can address any  
23   questions or concerns that may be present, you know, after reviewing the file  
24   record. And in this regard, this file is one of the largest files that I've  
25   handled in ten years of practice, and there have been many records.

1           So I understand that there may be many questions. There have  
2 been various permutations of the claims, and the claims themselves  
3 are -- well, Independent Claim 50, for example, is a full page and there's  
4 many features in there.

5           So if there's any questions or concerns that are present up front,  
6 I'd be happy to, you know, do my best to address anything that might  
7 be -- that you may have, and otherwise at any time.

8           Other than that, you know, I was hoping the second thing to  
9 bring out in requesting the hearing was to sort of just highlight that the two  
10 easiest grounds that we believe are present, in order to, you know, to justify  
11 reversing the Examiner's rejections.

12           So with reference to the materials that are provided, Figure 1,  
13 with highlighting, and that's shown in pink, and it corresponds to the most  
14 analogous parts of what's present in Figure 3 of the cited reference, and then  
15 I've also highlighted in pink the relevant parts of Claim 50.

16           And from that, it's just to explain our invention, you know, in a  
17 way that would be sort of easily understood or envisioned. It's what we're  
18 talking about is providing a plurality of information units, and it would be  
19 something like from a radio broadcast or a TV broadcast.

20           The information units would be present in the broadcast. It's  
21 sort of like interactive TV or interactive radio. This whole first clause of  
22 Claim 50, we've sort of revised this claim during prosecution, to really make  
23 clear that we're talking about a unidirectional, unidirectional  
24 communications, that it's the one-way direction.

25           So that it's not sort of something that's interactive between two  
26 parties. It's from an information provider, and that it's also a broadcast

1 program. So broadcast is another term that we think brings out, you know,  
2 this idea of something like a radio or television program, information units.

3 So in Figure 1 of our application, we show that, and I've  
4 highlighted this arrow in pink, as coming from the satellite. But of course  
5 that could come from a, you know, a TV channel or a radio tower. I mean  
6 it's going to a television in our Figure 1.

7 The closest part of the reference, of this Ferris reference, that  
8 corresponds to this, of what we're talking about, of providing a broadcast  
9 program and then information units, provided as part of a broadcast  
10 program, is highlighted.

11 Here in Ferris, I've highlighted this. The problem, and this is  
12 really one of the main problems with Ferris, is that you have a broadcast  
13 program, which is the highlighted portion on the right, from a content  
14 transmitter. But the most analogous part of Ferris that would correspond to  
15 our information units is something that's provided separately by these radio  
16 towers on the left.

17 So really that's, from the very beginning of Ferris, what they're  
18 talking about, what Ferris is directed to, is enhance that around maybe a  
19 radio receiver or something like that, a channel receiver, a remote control  
20 that receives signals from say a radio tower.

21 What Ferris is doing is it's synchronizing this information with  
22 the content or with the broadcast. But it's not providing the information as  
23 part of the broadcast. It's almost like a separate service, where someone is  
24 saying well, we know that, you know, Gray's Anatomy tonight is going to  
25 have these commercials, and it's going to have this content, or someone's  
26 going to be wearing these clothes.

1                   So we can synchronize with the broadcast in Gray's Anatomy or  
2 any, you know, really any show, some information about what someone's  
3 wearing or about a commercial. So what they're doing is they're providing  
4 this as a separate program, on that -- you know, via the service that's  
5 highlighted on the left.

6                   So that's really the first distinction that I can bring out, is in our  
7 first clause of Claim 50 and, you know, corresponding features on the  
8 independent claims, we're saying that the information units are provided as  
9 part of a broadcast program, as part of a unidirectional communication from  
10 an information provider.

11                  JUDGE HAHN: Counsel, if I understand you correctly, you're  
12 saying your claimed invention provides the commercial or infomercial as  
13 part of the broadcast transmission, and Ferris does not?

14                  MR. POSNER: Well, what we're doing is we have information  
15 that's provided as part of the broadcast that's not necessarily the commercial,  
16 and this is really only the first part of sort of a complex claim, is that we're  
17 providing some information or some information that's present and  
18 selectable in the broadcast program, so that it's part of the TV. So say from  
19 the TV program, rather than a separate service.

20                  JUDGE HAHN: So then the scope of information unit as  
21 recited in the claim is part of the issue here?

22                  MR. POSNER: This would be, and it would be in the context  
23 of the claim. So an information unit being selectable and part of a broadcast  
24 program. But yes, that would be --

25                  JUDGE HAHN: Continue. I apologize.

1           MR. POSNER: I'd just like to say that in the context of the  
2 claim, so these claims that were at Claim 50 now is the first independent  
3 claim. We've had many permutations of this. We've done our best to really  
4 highlight and draw out that this is part of a broadcast program, and it's not,  
5 you know, a secondary service that queued with it.

6           JUDGE HAHN: In reviewing the record here, we find that the  
7 Examiner has cited to paragraph, I believe 48 of Ferris, and in there, there is  
8 discussion in that paragraph regarding transmitting, I believe it's  
9 infomercials, commercials, through transmitter mechanism 404, which  
10 appears to be read on by information unit in the claim. That's the Examiner's  
11 position. What's your position?

12          MR. POSNER: Okay. So commercials would of course be  
13 provided with the television program, and we feel that this is even -- let me  
14 back up for one second. What we've addressed, and we've addressed what  
15 we believe is really the best interpretation of Ferris, so even that  
16 interpretation is even a lesser interpretation of Ferris. So that there's even  
17 more shortcomings, if you interpret a regular commercial as part of the  
18 information unit.

19          So what this is -- what this would -- what the problem would be  
20 with this commercial, with providing, with interpreting the commercial in  
21 Ferris, as part of our information unit, is really then the rest of the claim. So  
22 here what we have is we're talking about --

23          JUDGE MARTIN: Excuse me counsel, before you proceed.  
24 Are you saying -- I mean I'm still not sure I understand why information unit  
25 doesn't read on a commercial. Are you saying for the purpose -- are you  
26 going to assume that that's the case and explain why?

1 MR. POSNER: I can right here.

2 JUDGE MARTIN: Okay.

3 MR. POSNER: Okay. So if it's a commercial, an information  
4 unit being part of a broadcast program in our claim, and carrying  
5 information representing one of various items in such broadcast program.  
6 So here, if it's part of a commercial, if an information unit is part of the  
7 program, would we be saying if the information unit is a commercial and the  
8 broadcast program is the main show? And if so, then the commercial would  
9 have to carry information representing various items in the show, which that  
10 would not be something that's described in Ferris. There's other things  
11 though too.

12 JUDGE MARTIN: Well, before you move on --

13 MR. POSNER: Okay.

14 JUDGE MARTIN: Can't we just say that the broadcast  
15 program is the commercial?

16 MR. POSNER: Okay. If you say that, then if the broadcast  
17 program is the commercial, then you have -- let's see. Then you would have  
18 information units separate from the commercial, that represent one of  
19 various items in the commercial. So but that's just -- this is really just my  
20 starting point here.

21 JUDGE MARTIN: Well, can an information unit read on a  
22 frame of video information that's part of a commercial?

23 MR. POSNER: In the context of just the first clause, it could.

24 JUDGE MARTIN: Okay.

25 MR. POSNER: It could. So that's -- so if we broke apart that  
26 we have a commercial, and said okay, the broadcast program is the



1 commercial and an information unit is just some separable part of the  
2 commercial and it's part of the commercial, the problem then is this  
3 something. So you get to the orange part of the second --

4 JUDGE MARTIN: Oh, one other question before you move  
5 on. In Figure 4 of the reference, there's a display on the TV. It's something  
6 on the TV called the Tool Show.

7 MR. POSNER: Okay.

8 JUDGE MARTIN: I'm assuming that this is not a commercial;  
9 this is program. But why wouldn't that frame of information be an  
10 information unit that's a part of a program.

11 MR. POSNER: Okay, the Tool Show. So if it was additional  
12 information, and this -- actually, I think I can address both of these with the  
13 same point. It's the idea that in our claim, what we're talking about is these  
14 information units are selectable. So what we 'redoing, and so this is this  
15 idea, and well in our Figure 1, it's this orange part.

16 So the information unit is selectable by a person with -- the  
17 equivalent of a remote control. So that you could select this and send an  
18 identification back to -- well, to stores. So you would say I'm selecting -- I  
19 am Josh Posner, and I'm selecting this information unit. Please just  
20 remember that I selected this. It would say okay, this -- you know, no maybe  
21 an identification of the unit.

22 So what we're saying here then is the information recipient or  
23 verification identification data or verification data, identifies the information  
24 recipient, and identifying data particular to and distinctly identifying an  
25 information unit selected by the information recipient.

1           So if you have this commercial that you're describing, in Ferris  
2 that's not what's being selected by the recipient. Here in Ferris, if the  
3 commercial is what's being provided as part of the broadcast, what's being  
4 selected in Ferris is this information that's provided on the left, which is the  
5 program-associated data, universal ID and the program-associated data itself,  
6 which is from the secondary service.

7           JUDGE MARTIN: I'm sorry. Could you repeat that? I didn't  
8 follow that.

9           MR. POSNER: Sure. It's okay. So in the interpretation that  
10 you're requesting I explain, if a commercial is provided as part of the  
11 program, and if we say okay, the commercial is the information unit that's  
12 part of the broadcast program, okay, in Ferris there would of course be such  
13 a commercial.

14           However, that commercial is not what's being selected in Ferris.  
15 It's not the commercial itself. What's being selected is the information that  
16 I've highlighted in orange on the left. So you have with this remote  
17 controller, you have the queued and the synchronized data, and you have this  
18 going through a specialized handset, which is really the object of Ferris.

19           So you have this synchronized data. You select this data that's  
20 provided by the radio towers, and then this is the interactive part. So you  
21 select this. It sends your selection back through the radio service provider  
22 415. So there's a distinction. Okay, so you have -- if you have a commercial  
23 that's provided as an information unit as part of a program, and I think that  
24 that's a reasonable first impression reading, it's ultimately that's not what's  
25 being selected in Ferris.

1 JUDGE MARTIN: In Ferris, let's take a look at Figure 4 of  
2 Ferris again. It's got the whole show, program on it, and we'd see a display  
3 on the hand-held remote there, and it says "B&F power drill." Somehow,  
4 that remote knows which signal to pick up, this PAD information.

5 It somehow knows which of all the various things that could be  
6 displayed here, which one do you show. Isn't it tied to the channel that's  
7 being launched?

8 MR. POSNER: Is that enough?

9 JUDGE MARTIN: It is. Well, I don't think because here, it's  
10 what's being selected is what's showing up on your handset, and this is  
11 program-associated data. So it's related to, but it's being provided. In fact,  
12 the way that Ferris is operating is they're queuing this data.

13 So they're synchronizing it and saying okay, you know, Gray's  
14 Anatomy or the commercials in Gray's Anatomy are going to come from the  
15 radio tower, and if you have a special handset, we're going to provide extra  
16 data from, you know, from the advertisers for instance, or from whoever  
17 made the outfits that the actors are wearing. So that's what's being selected  
18 as the secondary service and the secondary data.

19 But there is initial channel selection involved here, right? I  
20 mean there's somebody picked the channel to watch the Tool Show?

21 MR. POSNER: Correct.

22 JUDGE MARTIN: All right. So that's some kind of selection  
23 that's going on even before the display shows up on the remote.

24 MR. POSNER: Yes, and that would be --

25 JUDGE MARTIN: In fact, that's what steers what's displayed.  
26 I'm sorry, go ahead.

1               MR. POSNER: Oh yes, and that would be a selection of a  
2 show, but not a selection of an information unit.

3               JUDGE MARTIN: All right. So you're saying that information  
4 unit, you have to specifically select a part of a show, like --

5               MR. POSNER: In fact, in the examples, what we have in our  
6 description, I realize that our claims don't read exactly on the details of the  
7 description. But it would be this idea that if you have something that comes  
8 from a -- in Gray's Anatomy, I'll give you an example, and someone said  
9 okay, we want to highlight a dress that an actress is wearing or an outfit or a  
10 hat that someone's wearing, and it might highlight on the show, so that it's  
11 selectable.

12              That would be it. You would say "I see that this hat is  
13 selectable. I'm selecting it from the broadcast itself," and later on, and this  
14 really pertains to the rest of the claim, it will store that, and say "Okay, Josh  
15 Posner selected this and he said remember that I selected this, you know,  
16 whatever is provided as part of the broadcast itself from the broadcaster.  
17 That's what the selection is."

18              And so that's really the first half of the claim. We think that  
19 that's -- that's sort of a fundamental distinction, where we've said that it's  
20 coming from a unidirectional communication, so that yes, it could be, as you  
21 indicated, it could initially read on a commercial, but then it's not that the  
22 commercial itself is selectable. What's selectable is the secondary data, you  
23 know, the secondary service that comes from the radio tower, the pink  
24 arrows on the left, that are highlighted in the middle.

25              So that's -- you can see in what I've highlighted is this handset  
26 here ties in through the radio towers, so that it's ultimately what you're

1 selecting and what the back end data is this selection, through the radio  
2 towers, of the program-associated data, and you're using, you know, using  
3 your identification data.

4           Okay, and so are there any other questions that I can address  
5 maybe for this first part of this?

6           JUDGE MARTIN: No. Proceed.

7           MR. POSNER: Okay, thank you very much. The second part,  
8 and this is maybe not as, we think, even not as easy to necessarily state. But  
9 it's this part that's engrained. So okay. What we're ultimately doing then is  
10 when you select this information unit as part of a broadcast, as part of a  
11 broadcast program in our claim.

12           What's ultimately happening is your selection and your  
13 identification are going to an information manager, and this is that part of  
14 the claim that's in orange and then the part in the middle that's in green. And  
15 this is really the second trick here, is -- so it says okay, you have a hat.  
16 You've selected a hat and you can see that the hat was red and maybe  
17 whatever else.

18           What happens is at the program manager, this information, this  
19 identifying data of the selectable information unit, is unassociated with  
20 secondary data. The secondary data, we refer to it as reference data. So that  
21 the reference data is associated with the defining features of the information  
22 manager.

23           So here, this idea of the reference data would be stuff, as you  
24 indicated in your Figure 4. If we ignored the nature of the selection, the  
25 reference might be where you could buy the hat. If you, you know, it could  
26 be the price or who the designer is. So it would be secondary information.

1           Or if you're watching, say public, public housing on an  
2 information show; it could be oh that park you're looking at is this national  
3 park and this national park is located here on the map, and here's who you  
4 call or where you write and get on that site on how to visit it. But it's this  
5 idea that you have this reference data that's tied to it.

6           So that leads to the final part of the claim, which is okay, so that  
7 ultimately you can go in, using a second device. The second device isn't, we  
8 think, necessarily an important argument here. The second device is brought  
9 in to address earlier rejections that have since then been withdrawn.

10           But this idea of what you can do then is if you have a computer,  
11 we can log into say a website that is associated with this program, and it will  
12 say okay, you're Josh Posner, and recently you've selected a hat on Gray's  
13 Anatomy or this program on PBS, and what we can do is we can tell you  
14 about whatever you select. If it's a hat, you can buy it for this price and the  
15 designer is so and so from, you know, whatever was designing this here, or  
16 you can buy it at this store.

17           Or, you know, the reference data that, you know, might be  
18 helpful to you because you were interested in this and you selected it, could  
19 be this park is located in this state, you know, and whatever else. So  
20 ultimately this is the idea of reference data, and so we've actually used words  
21 here to -- that were brought in during prosecution, and this is to distinguish  
22 the claims, or maybe sort of characterize the claims in a way that would not  
23 read on art that was cited during prosecution.

24           So here we say in the middle part reference data that was  
25 associated with and defining features of the information unit selected by the  
26 information recipient, and under what we feel is the best interpretation of,

1 you know, an information unit in Ferris, and this isn't necessarily, you know,  
2 the idea of a commercial, but it's this idea of the program associated data,  
3 what's on the left in the claim.

4 And so what the reference data, the way that we believe that  
5 we're distinguishing from this program-associated data and what's  
6 retrievable in Ferris is Ferris describes in one paragraph. They say okay,  
7 you can look up and if you purchase something, for instance, in a  
8 commercial in Ferris, what Ferris describes is that you can view your  
9 transaction history.

10 So you might have a credit card on file, and so if you want to  
11 review what did I buy? Did I accidentally press a button or what have my  
12 kids bought, you know, from watching TV by pressing buttons on this  
13 specialized remote control, you can review transactions.

14 And so the transactions, it actually says, it's an expanded  
15 graphical display relative compared to what you can view on the remote  
16 control itself. What Ferris says is well, this transaction history can be better  
17 colors and more clarity, and maybe an expanded version. But you can  
18 review that on a computer then.

19 So in Ferris you do have the second device, and that's a  
20 distinction that we're not drawing with Ferris. That was a distinction -- the  
21 second device was brought in, you know, previously to distinguish from  
22 other art. But it's this ideas, our arguments that we presented during  
23 prosecution is that while reference data in our claim is associated with and  
24 defining features of the information unit selected by the information  
25 recipient, whereas a transaction history, we don't believe that that would read  
26 on associated with and defining features of the information unit.

1 JUDGE MARTIN: Well it seems to me, excuse me, that the  
2 description of this home computer is not just limited to retrieving transaction  
3 histories. It sounds like it gives you the same information that you would  
4 also get with the remote, when it says in paragraph 61 "have access to all the  
5 facilities offered by the handset 417." It sounds like an alternative way to do  
6 what you can -- get what you can get or see on the remote, right?

7 MR. POSNER: That's absolutely correct.

8 JUDGE MARTIN: Then why isn't that enough for the -- that's  
9 more than transaction history. That's the same, PAD, whatever it is, that is --

10 MR. POSNER: The program associated data, yes. So that's the  
11 information. So if the program-associated data is the information unit, and  
12 that we believe is the best interpretation. It's an information unit of being  
13 part of -- well, it's an information unit, but it's not part of a broadcast  
14 program.

15 But if it is an information unit, that would your information  
16 units. So here we have the identification data for the information units, to  
17 identify them. Then the reference history or the reference data, which  
18 is -- we think that this would be read as sort of an expansion of the initial  
19 data that you receive.

20 JUDGE MARTIN: But this position assumes that you can't  
21 read the claimed information units on say a commercial that's being  
22 broadcast.

23 MR. POSNER: For this, yes, and we think that that's sort of an  
24 initial -- when we've gone back and forth to the Examiner, that that's sort of  
25 a starting point, is that if it's a commercial, the commercials themselves



1 aren't selectable. What's selectable, and this goes back to another thing. The  
2 selectable part is what's provided on the, you know, radio.

3 But so we think that this identifies or this idea of the reference  
4 data, that it would read -- that it reads in a sense as being different or  
5 expansionary. But that also is, I think, specified in various of the dependent  
6 claims. So we said well, we don't have to say that it's, you know, an  
7 expansion or additional information or whatever. It should just be  
8 understood that reference data is not itself the identification data or the  
9 information units that are selected.

10 So that each one of them is slightly different in scope, you  
11 know, or meaning. So but I understand what you're saying, and we've  
12 actually sort of -- that was actually our argument to the Examiner, that this is  
13 what is being provided to the radio controller. It's not NOR (ph). It's not in  
14 a sense back on data that an advertiser or that a show provider is waiting to  
15 provide you.

16 JUDGE MARTIN: All right. Any further questions?

17 JUDGE HAHN: I don't.

18 JUDGE WHITEHEAD: No.

19 JUDGE MARTIN: No further questions. Thank you very  
20 much.

21 MR. POSNER: Okay, thank you.

22 [BREAK]

23 MR. POSNER: I would just like to add one more thing, and  
24 that's just the idea that there are various dependent claims that have been  
25 separately argued. So that's -- they expand on some of the ones that we've  
26 highlighted in our appeal brief expand on, you know, additional details that

1 relate to this idea of what an information unit is and, you know, what  
2 a -- what the reference data is.

3               So I think in fact the last of the dependent claims each might  
4 say that the reference data is additional to the information units.

5               JUDGE MARTIN: All right. Thank you, Mr. Posner.

6               MR. POSNER: Okay. Thank you very much.

7               Whereupon, at 10:00 a.m., the proceedings were concluded.

8

9

10

11